



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,848	10/16/2000	Scott E. Andersen	16517.001/38-21(51463)B	1817

7590 08/27/2002

Lawrence M. Lavin, Jr.  
Patent Department, E2NA  
Monsanto Company  
800 N. Lindbergh Boulevard  
St. Louis, MO 63167

EXAMINER

SISSON, BRADLEY L

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 08/27/2002

#10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/688,848

**Applicant(s)**

ANDERSEN ET AL.

**Examiner**

Bradley L. Sisson

**Art Unit**

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 2-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, and the species of SEQ ID NO: 1 in Paper No. 9, received 15 July 2002, is acknowledged. The traversal is on the ground(s) that restriction to a single nucleotide sequence is improper and that no serious burden would be placed on the Office by having to conduct a search and examination of at least ten sequences. Argument is also presented that the inventions of Groups I and II should be combined as they are sufficiently related. This is not found persuasive because each sequence is recognized as being drawn to a different chemical compound that is distinct from every other chemical compound. No evidence has been presented that the over six thousand different sequences are actually the same sequence. The aspect of conducting a search of ten or more sequences does place an undue burden on the Office and to the aspect of searching over six thousand different disclosed sequences, much less the infinite number of fragments and sequences that have any degree of complementarity, would clearly require a tremendous expenditure of time and capital on the part of the Office. Further, the aspect of the inventions of Groups I and II being examined together would require additional searches and consideration of issues while undergoing examination sufficiently diverse from that of examination of the sequences per se that an undue burden would also be placed. Evidence of the burden is demonstrated by their different classifications and by the fact that a search of the invention of Group I is not coextensive with that for Group II.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 1634

2. Claims 2-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 9.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: Claim 1 has sufficient breadth of scope such that it encompasses non-elected sequences or inventions. Appropriate correction is required.

### ***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

5. The disclosure is objected to because of the following informalities: The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

### ***35 U.S.C. 101/112 Utility Rejections***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 1634

Definitions: [from REVISED INTERIM UTILITY GUIDELINES TRAINING MATERIALS;  
repeated from <http://www.uspto.gov/web/menu/utility.pdf> ]

"Credible Utility" - Where an applicant has specifically asserted that an invention has a particular utility, that assertion cannot simply be dismissed by Office personnel as being "wrong". Rather, Office personnel must determine if the assertion of utility is credible (i.e., whether the assertion of utility is believable to a person of ordinary skill in the art based on the totality of evidence and reasoning provided). An assertion is credible unless (A) the logic underlying the assertion is seriously flawed, or (B) the facts upon which the assertion is based is inconsistent with the logic underlying the assertion. Credibility as used in this context refers to the reliability of the statement based on the logic and facts that are offered by the applicant to support the assertion of utility. A *credible* utility is assessed from the standpoint of whether a person of ordinary skill in the art would accept that the recited or disclosed invention is currently available for such use. For example, no perpetual motion machines would be considered to be currently available. However, nucleic acids could be used as probes, chromosome markers, or forensic or diagnostic markers. Therefore, the credibility of such an assertion would not be questioned, although such a use might fail the *specific* and *substantial* tests (see below).

"Specific Utility" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention. For example, a claim to a polynucleotide whose use is disclosed simply as a "gene probe" or "chromosome marker" would not be considered to be *specific* in the absence of a disclosure of a specific DNA target. Similarly, a general statement of diagnostic utility, such as diagnosing an unspecified disease, would ordinarily be insufficient absent a disclosure of what condition can be diagnosed.

"Substantial utility" - a utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities. For example, both a therapeutic method of treating a known or newly discovered disease and an assay method for identifying compounds that themselves have a "substantial utility" define a "real world" context of use. An assay that measures the presence of a material which has a stated correlation to a predisposition to the onset of a particular disease condition would also define a "real world" context of use in identifying potential candidates for preventive measures or further monitoring. On the other hand, the following are examples of situations that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use and, therefore, do not define "substantial utilities":

A. Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved.

Art Unit: 1634

B. A method of treating an unspecified disease or condition. (Note, this is in contrast to the general rule that treatments of specific diseases or conditions meet the criteria of 35 U.S.C. 101.)

C. A Method of assaying for or identifying a material that itself has no "specific and/or substantial utility".

D. A method of making a material that itself has no specific, substantial, and credible utility.

E. A claim to an intermediate product for use in making a final product that has no specific, substantial, and credible utility.

Note that "throw away" utilities do not meet the tests for a *specific* or *substantial* utility. For example, using transgenic mice as snake food is a utility that is neither specific (all mice could function as snake food) nor substantial (using a mouse costing tens of thousands of dollars to produce as snake food is not a "real world" context of use). Similarly, use of any protein as an animal food supplement or a shampoo ingredient are "throw away" utilities that would not pass muster as specific or substantial utilities under 35 U.S.C. ' 101. This analysis should, of course, be tempered by consideration of the context and nature of the invention. For example, if a transgenic mouse was generated with the specific provision of an enhanced nutrient profile, and disclosed for use as an animal food, then the test for specific and substantial *asserted* utility would be considered to be met.

"Well established utility" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art. "Well established utility" does not encompass any "throw away" utility that one can dream up for an invention or a nonspecific utility that would apply to virtually every member of a general class of materials, such as proteins or DNA. If this is the case, any product or apparatus, including perpetual motion machines, would have a "well established utility" as landfill, an amusement device, a toy, or a paper weight; any carbon containing molecule would have a "well established utility" as a fuel since it can be burned; any protein would have well established utility as a protein supplement for animal food. This is not the intention of the statute.

See also the MPEP at 2107 - 2107.02.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1634

8. Claim(s) 1 is(are) rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility due to its not being supported by either specific and/or substantial utility or a well established utility.

9. The claimed nucleic acid and/or protein compound(s) is (are) not supported by a specific asserted utility because the disclosed use(s) of the nucleic acid(s) and/or protein(s) is (are) not specific and is (are) generally applicable to any nucleic acid and/or protein. The specification states that the nucleic acid compounds may be useful as probes for assisting in the isolation of full-length cDNAs or genes which would be used to make protein and optionally further usage to make the corresponding antibodies, gene mapping, isolation of homologous sequences, detection of gene expression such as in Northern blot analysis, molecular weight markers, chromosomal markers, and for numerous other generic genetic engineering usages. Similarly, protein may be used for detection of expression, antibody production, Western blots, etc. These are non-specific uses that are applicable to nucleic acid(s) and/or proteins in general and not particular or specific to the nucleic acid(s) and/or protein(s) being claimed.

10. Further, the claimed nucleic acid and/or protein compound(s) is (are) not supported by a substantial utility because no substantial utility has been established for the claimed subject matter. For example, a nucleic acid may be utilized to obtain a protein. The protein could then be used in conducting research to functionally characterize the protein. The need for such research clearly indicates that the protein and/or its function is not disclosed as to a currently available or substantial utility. A starting material that can only be used to produce a final product does not have substantial asserted utility in those instances where the final product is not supported by a specific and substantial utility. In this case none of the proteins that are to be produced as final products resulting from processes involving claimed nucleic acid have asserted or identified specific and substantial utilities. The research contemplated by applicant(s) to characterize potential protein products, especially their biological activities, does not constitute a specific and substantial utility. Identifying and studying the properties of a protein itself or the mechanisms in which the protein is involved does not define a "real world" context or use. Similarly, the other listed and asserted utilities as summarized above or in the instant specification are neither substantial nor specific due to being generic in nature and applicable to a myriad of such compounds. Note, because the claimed invention is not supported by a specific

Art Unit: 1634

and substantial asserted utility for the reasons set forth above, credibility has not been assessed. Neither the specification as filed nor any art of record discloses or suggests any property or activity for the nucleic acid and/or protein compound(s) such that another non-asserted utility would be well established for the compounds.

11. Claim(s) 1 is (are) also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention.

12. Claim 1 encompasses sequences that are less than full-length cDNA. None of these sequences meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

13. *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116.)

14. The skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993), and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

15. Finally, *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404, 1405 held that:

To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); In



Art Unit: 1634

*re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

An adequate written description of a DNA, such as the cDNA of the recombinant plasmids and microorganisms of the '525 patent, "requires a precise definition, such as by structure, formula, chemical name, or physical properties," not a mere wish or plan for obtaining the claimed chemical invention. *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). Accordingly, "an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself." *Id.* at 1170, 25 USPQ2d at 1606.

16. Accordingly, the specification does not provide a written description of the invention of claim 1.

### ***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Life Technologies.
19. Life Technologies (Gibco BRL products & Reference Guide) disclose for sale at page 17-19 random primers that are primarily hexanucleotides. The population of hexamers is considered to have as an inherent property nucleic acid sequences that would encode at least two amino acids that are also encoded by SEQ ID NO: 1.

Art Unit: 1634

***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978.

The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

22. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Bradley L. Sisson  
Primary Examiner  
Art Unit 1634

BLS  
August 21, 2002